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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,928	12/28/2000	Steven H. Mccown	00-070-DSK	9043

7590 05/20/2004

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EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/750,928	<b>Applicant(s)</b> MCCOWN ET AL.	
	<b>Examiner</b> Longbit Chai	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. This application is filed on 12/28/00 but claims the benefit of U.S. provisional application number 60/218,756 filed on July 17, 2000.
2. Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 7/17/2000.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1, 16 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 9 of copending Application No. US 2002/0124131. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same limitations are recited in the body of the claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 4, 6 – 8, 10, 16 – 19, 21 – 23 and 25 are rejected under 35

U.S.C. 102(e) as being anticipated by Jussy (Publication Number: US 2002/0032872 A1), hereinafter referred to as Jussy.

5. As per claims 1, 16 and 26, Jussy discloses a method (or system) for upgrading a user environment, wherein the user environment has a product (or service) with a component operable to run at a low operating level and a high operating level, the component of the product (or service) being set to operate at the low operating level, the method comprising:

a. associating an upgrade key with the product (or service), the upgrade key having permission instructions for the component of the product (or service) to operate at the high operating level (Jussy: inter alia, Parag [0026], Parag [0044], Parag [0028] Line 8 – 10, Parag [0023] Line 5 – 7); and

b. enabling the component of the product (or service) to operate at the high operating level in response to the upgrade key being associated with the product (or service) in order to upgrade the user environment (Jussy: inter alia, Parag [0018] Line 4 – 5).

6. As per claims 2 and 17, Jussy teaches the claimed invention as described above (see claims 1 and 16 respectively). Jussy further teaches associating a security mechanism with the product, the security mechanism containing permission instructions for the component of the product to run at the low operating level, wherein the security mechanism updates the permission instructions for the component to run at the high operating level upon the upgrade key being associated with the product (Jussy: inter alia, Parag [0027] Line 15 – 22 and Parag [0039] Line 1 – 2).

7. As per claims 3 and 18, Jussy teaches the claimed invention as described above (see claims 1 and 16 respectively). Jussy further teaches the product is a computer (Jussy: inter alia, Parag [ 0007] and Parag [0019] Line 26 – 30).

8. As per claim 4 and 19, Jussy teaches the claimed invention as described above (see claims 3 and 18 respectively). Jussy further teaches the component is a central processing unit of the computer (Jussy: inter alia, Parag [ 0007], Parag [0019] Line 26 – 30 and central processing unit is inherited from a computer).

9. As per claim 6 and 21, Jussy teaches the claimed invention as described above (see claims 3 and 18 respectively). Jussy further teaches the component is random access memory of the computer (Jussy: inter alia, Parag [ 0007], Parag [0019] Line 26 – 30 and random access memory is inherited from a computer).

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10. As per claim 7 and 22, Jussy teaches the claimed invention as described above (see claims 3 and 18 respectively). Jussy further teaches the component is software of the computer (Jussy: inter alia, Parag [ 0007], Parag [0019] Line 26 – 30 and software is inherited from a computer).

11. As per claim 8 and 23, Jussy teaches the claimed invention as described above (see claims 1 and 16 respectively). Jussy further teaches the upgrade key is a cryptographic update key (Jussy: inter alia, Parag [ 0037] Line 4 – 6).

12. As per claim 10 and 25, Jussy teaches the claimed invention as described above (see claims 1 and 16 respectively). Jussy further teaches associating an upgrade key with the product includes transferring the update key from the Internet to the product (Jussy: inter alia, Parag [ 0027] Line 19 – 22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jussy (Publication Number: US 2002/0032872 A1), hereinafter referred to as Jussy (as applied to claim 1, 3, 16, and 18 above), in view of O'Brien (Patent Number: US 6351776 B1), hereinafter referred to as O'Brien.

14. As per claim 5 and 20, Jussy teaches product upgrade key for enabling and disabling the use of network elements in a distributed network and product upgrade key is associated with a computer (see claims 1, 3, 16, and 18 respectively). Jussy does not expressly teach a hard disk is the component of a computer. O'Brien teaches a hard disk is the component of a computer as a network element (O'Brien: see inter alia, Column 5 Line 60 – 63).

15. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of O'Brien within the system of Jussy because O'Brien addresses the demand by providing means by which files and other

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data can be stored on the Internet and made available worldwide through the Internet (O'Brien, see inter alia, Column 3 Line 1 – 4).

16. As per claim 9 and 24, Jussy teaches product upgrade key for enabling and disabling the use of network elements in a distributed network (see claim 1 and 16 respectively). Jussy does not expressly teach associating an upgrade key with the product includes associating a smart card having the upgrade key with the product.

17. Official Notice is taken that the use of smart card is a well-known portable computer technology that stores the security key and facilitates cryptographic key processing. Therefore, It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use smart card within the system of Jussy.

18. Claims 11 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jussy (Publication Number: US 2002/0032872 A1), hereinafter referred to as Jussy (as applied to claim 1 above), in view of Clark (Publication Number: US 2001/0011254 A1), hereinafter referred to as Clark.

19. As per claim 11, Jussy teaches product upgrade key for enabling and disabling the use of network elements in a distributed network (see claim 1). Jussy does not expressly teach disabling the component of the product from operating at the high operating level in response to the upgrade key being associated with the product after expiration of a lease period.

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20. Clark teaches disabling the component of the product from operating at the high operating level in response to the upgrade key being associated with the product after expiration of a lease period (Clark: see inter alia, Parag [0322] Line 36 – 44: Clark teaches the license criteria to associate the time intervals with the security key (i.e., time usage period can be established by the vendor or service provider (Clark: see inter alia, Parag [0322] Line 36 – 44).

21. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Clark within the system of Jussy because Clark discloses a method of protecting the software product from unauthorized or unlicensed use (Clark: see inter alia, Parag [0020] Line 1 – 2) and software is one of the system components in the user environment.

22. As per claim 12, Jussy teaches the claimed invention as described above (see claim 1). Jussy does not teach enabling the component of the product to operate at the high operating level for a single use of the product.

23. Clark teaches enabling the component of the product to operate at the high operating level for a single use of the product (Clark: see inter alia, Parag [0322] Line 36 – 44: Clark discloses the licensing criteria that allows the vendor (or service provider) to limit the number of times the software can run before the user key expires by setting a maximum number of uses per user key).

24. Same rationale of combination applies here as above in rejecting the claim 11.

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25. As per claim 13, Jussy teaches the claimed invention as described above (see claim 1). Jussy does not teach enabling the component of the product to operate at the high operating level for multiple uses of the product.

26. Clark teaches enabling the component of the product to operate at the high operating level for multiple uses of the product (Clark: see inter alia, Parag [0322] Line 36 – 44). Same rationale of combination applies here as above in rejecting claim 11.

27. As per claim 14, Jussy teaches the claimed invention as described above (see claim 1). Jussy does not teach enabling includes enabling the component of the product to operate at the high operating level permanently.

28. Clark teaches enabling includes enabling the component of the product to operate at the high operating level permanently (Clark: see inter alia, Parag [0322] Line 36 – 44: licensing the considerably long period of time over a product life cycle). Same rationale for combination applies here as above in rejecting claim 11.

29. As per claim 15, Jussy teaches the claimed invention as described above (see claim 1). Jussy does not enabling includes enabling the component of the product to operate at the high operating level temporarily.

30. Clark teaches enabling includes enabling the component of the product to operate at the high operating level temporarily (Clark: see inter alia, Parag [0322] Line 36 – 44: licensing a time usage period can be established). Same rationale for combination applies here as above in rejecting claim 11.

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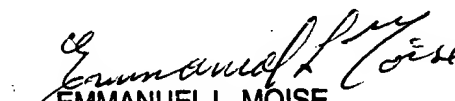
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 703-305-0710. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai  
Examiner  
Art Unit 2131

LBC

  
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A/11 2136